

REMARKS

Claims 1-15 are now pending in the present application. Applicants have carefully studied the outstanding Office Action. The present Response is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of this application is respectfully requested in view of the following remarks.

CLAIM REJECTIONS – 35 U.S.C. §103(a)

Claims 1-15

The Examiner rejects claims 1-15 under 35 U.S.C. §103(a), as being unpatentable over Wilkins et al. (U.S. Publication No. 2004/0133924). The Examiner states:

Wilkins et al. disclosed (e.g., see Figs. 1-8) the invention substantially as claimed. Taking claims 1, 4-5 and 8 as exemplary claims, the reference disclosed a system for synchronizing (e.g., see the abstract, item 450 of Fig. 4) a multiplicity of devices in multimedia (450 of Fig. 4) environment, comprising:

a) at least one central storage (e.g., on-line photo sharing sites, see § 11) and an interface device, wherein audio, video and photographic information (e.g., multimedia of Fig. 4) are stored in digital form. And this multimedia is updated (e.g., modified) in relation with other specific storage, whereby the at least a user or multiple users can access substantially identical multimedia related to the at least one user (e.g., see § 14 and last 3 lines of § 17).

While Wilkins et al. disclosed a plurality of host computers, a server computer and other devices connected to each other by a network 406, Wilkins et al. did not explicitly mention the term "zone" or zone specific storage". It would have been obvious to one of ordinary skill in the art to recognize that such "zone specific storage" would have been a storage of the server 404).

* * *

As to claims 2, 3, 6, 7 and 13-15, such feature of either hardwired or wireless LAN or WAN, a network connection, and wireless mobile device are the well known feature and well within one of ordinary skill in the art at the time the invention was made.

* * *

As to claims 11 and 12, Wilkins et al. taught also the feature of A/D conversion (e.g., see A/D converter 208 and the processor system 200 of Fig. 2).

Response:

For the following reasons, the Examiner's rejection is respectfully traversed.

It Is The Examiner's Burden To Establish Obviousness

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. *In re Oetiker*; *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*; *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). In response to an assertion of obviousness by the Patent Office, the applicant may simply attack the Patent Office's *prima facie* determination as improperly made out. *In re Fritch*, 972 F.2d at 1265, 23 U.S.P.Q.2d at 1783. In point of fact, the Examiner has failed to make such a *prima facie* showing.

There Is No Teaching, Incentive, Or Suggestion Supporting The Examiner's Proposed Combination Of Prior Art

A proper *prima facie* case of obviousness cannot be established by combining the teachings of the prior art absent some teaching, incentive, or suggestion supporting the

combination. *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995); *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990). The Examiner admits that there are differences between the cited portions of Wilkins et al. and each of Applicants' claims. Yet the Examiner did not even allege, much less prove, that some teaching, incentive or suggestion existed to combine teachings of the prior art with Wilkins et al. to reach Applicants' claimed invention. For this reason alone, none of Applicants' claims should have been rejected.

The Examiner's Characterization of What is Disclosed by the Prior Art is Incorrect

Furthermore, the Examiner's arguments regarding obviousness depend entirely on the contention that Wilkins et al. discloses synchronization of audio, video and photographic information. In point of fact, Wilkins et al. only teaches synchronization of digital photos. This is yet another independent reason that Applicants' claim should not have been rejected.

The Prior Art Cited By The Examiner Would Not Address The Problem Solved By Request's Invention Even If The Changes To The Prior Art Suggested By The Examiner Were Made

Even if the purportedly obvious modifications suggested by the Examiner were made to Wilkins et al., the resulting updated teaching would not address the problem solved by Applicants' claimed invention. The cited disclosure of Wilkins' et al. teaches how to synchronize edits made to a digital photo when multiple copies of that digital photo exist. There is not even a hint that when a new, unedited digital photo is added to one of the interconnected devices that the identical new, unedited digital photo is copied to each of the interconnected devices. Applicants' claimed invention of course requires that any new multimedia content added to one of the storage and interface device be accessible by any of the other storage and interface devices. Since even the modifications to Wilkins et al. suggested by the Examiner

would not describe Applicants' claimed invention, Applicants' claimed invention is not properly rejected as being obvious.

The Prior Art Cited By The Examiner Teaches Away From Request's Claimed Invention

A reference "teaches away" from the claimed invention when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2D 1130, 1131 (Fed. Cir. 1995). Wilkins et al. actually teaches away from making substantially identical content available on each of the interconnected devices of Applicants' claimed invention, which is a limitation of each of Applicants' claims. For example, Wilkins et al. expressly suggests that copies of the digital photo residing on some other interconnected devices be made very small in comparison to the original file. See Wilkins et al., ¶¶ 30-32. This makes little sense in the context of the audio and video information synchronized by Applicants' claimed invention—e.g., a user will not want to access substantially inferior audio information on any of the devices. Thus, the prior art cited by the Examiner teaches away from Applicants' claimed invention and cannot form the basis for an obviousness rejection.

The Underlying Purpose Of Request's Invention Is Non-Analogous To The Prior Art

Finally, Applicants' claimed invention is not obvious because the underlying purposes of the cited portions of Wilkins et al. and Applicants' claimed invention are considerably different. Wilkins et al. discloses synchronizing changes made to specific, individual digital images distributed amongst a group of interconnected devices. In contrast, Applicants' claimed invention updates multiple storage and interface devices so that substantially identical audio,

video and photographic information resides on each of multiple storage and interface devices. Applicants' claimed invention, however, does not synchronize changes to individual files because the content of individual multimedia files is never changed. Since the underlying purposes are non-analogous, there would have been no incentive or motivation to modify Wilkins et al. to reach Applicants' claimed invention.


CONCLUSION

It is respectfully urged that the subject application is patentable over the reference cited by Examiner and is now in condition for allowance. Applicants request reconsideration of the application and allowance of the claims. If there are any outstanding issues that the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact David W. Carstens at 972.367.2001.

The Commissioner is hereby authorized to charge any additional payments that may be due for additional claims to Deposit Account 50-0392.

Respectfully submitted,

By:


David W. Carstens
Registration No. 34,134
Attorney for Applicants

Date: March 13, 2006

CARSTENS & CAHOON, LLP
P.O. Box 802334
Dallas, TX 75380
(972) 367-2001 Telephone
(972) 367-2002 Facsimile